

Patent Briefing Paper:

European Patent

DISCLAIMER PRACTICE AT THE EPO CLARIFIED – G1/03 and G2/03

The EPO Enlarged Board of Appeal recently issued its decisions on the allowability of “undisclosed disclaimers”. These decisions stem from referrals by Appeal Boards 3.3.4 and 3.3.5 following the earlier decision **T323/97** which held that such disclaimers are unallowable on the basis that they introduce new matter not disclosed in the application as filed, contrary to Article 123(2) EPC. Both referring boards discerned a contradiction between the conclusion reached in T323/97 and earlier case law of the EPO which held such disclaimers to be allowable in certain circumstances.

The Enlarged Board has clarified the position at the EPO regarding the use of undisclosed disclaimers (that is disclaimers which do not find a specific basis in the application as filed). In essence, the Enlarged Board has rejected the reasoning of T323/97 and confirmed the previous EPO case law and practice under which such disclaimers were considered allowable.

The specific questions put to the Enlarged Board of Appeal were answered as follows:

- 1. An amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed.***

Our comments:

This sets out the basic position that undisclosed disclaimers do not necessarily add new matter, which was the conclusion reached in T323/97.

- 2. The following criteria are to be applied for assessing the allowability of a disclaimer which is not disclosed in the application as filed:***

2.1 A disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;***

Our comments:

State of the art under Article 54(3) and 54(4) EPC are European patent applications for which the effective filing date is before, but the publication date after, the effective filing date of the application (or patent in the case of opposition proceedings) under consideration. Such prior, unpublished European patent applications are prior art in respect of the common designated states for the purposes of novelty but not inventive step.

- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and***

Our comments:

State of the art under Article 54(2) EPC is everything made available to the public by any means before the effective filing date of the application or patent under consideration. An example of an accidental anticipation is a document directed to a compound which has a pharmaceutical activity, where the invention is directed to the same compound but for use as a fuel additive.

- disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.***

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Our comments:

Subject-matter which is not patentable for technical reasons includes, for example, methods for treatment of the human or animal body by surgery or therapy, and diagnostic methods practiced on the human or animal body. Thus, a claim directed to a method which embraces allowable methods but which additionally embraces unallowable methods of treatment may have its novelty restored by way of a disclaimer along the lines "with the proviso that the method is not a method of treatment of the human or animal body".

2.2 A disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.

Our comments:

Care will need to be taken when drafting disclaimers to ensure that the disclaimer is compounds with the prior art disclosure to be disclaimed.

2.3 A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Article 123(2) EPC.

Our comments:

This is the "sting in the tail". One of the arguments which underpinned the reasoning of T323/97 was that it could never be ruled out that a disclaimer introduced to establish novelty could give an advantage to the patent proprietor in the event that the relevant facts changed. For example, the disclaimer might have the effect of excluding subject-matter disclosed in a document available for assessment of inventive step which emerges in proceedings after the introduction of the disclaimer. The decision of the Enlarged Board makes clear that in such circumstances the disclaimer becomes vulnerable to an attack that it introduces new matter.

Our view is that disclaimers should thus be used with considerable care, and that consideration should always be given to the inclusion of suitable dependent claims as fall back positions and, if possible, to the inclusion of other independent claims which do not contain the disclaimer.

2.4 A claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC.

Our comments:

Disclaimers will need to be written in such a way that the meaning of the disclaimer is clear and concise. It is likely that multiple disclaimers will not normally be permitted.

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